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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,496	02/07/2001	David M. Lubman	UM-06106	8813

23535 7590 07/26/2002

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SAN FRANCISCO, CA 94105

EXAMINER

MAHATAN, CHANNING

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 07/26/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/778,496

Applicant(s)

LUBMAN ET AL.

Examiner

Channing S. Mahatan

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☒ Claim(s) 15, 16, 21, and 34 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☒ Other: *Attachment for PTO-948*.

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## **DETAILED ACTION**

### *ART UNIT DESIGNATION*

The Group and/or Art Unit designated for this application has changed. Applicants are hereby informed that future correspondence regarding this application should be directed to Group Art Unit 1631.

### *OBJECTION BY DRAFTSMAN*

Applicants are hereby notified that the required timing for correction of drawings has changed. See the last 6 lines on the sheet, which is attached, entitled "Attachment for PTO-948 (Rev. 03/01 or earlier)". Due to the above notification applicants required to submit drawing corrections with the time period set for responding to this Office action. Failure to respond to this requirement may result in abandonment of the instant application or a notice of a failure to fully respond to this Office action.

### *CLAIMS UNDER EXAMINATION*

Claims herein under examination are claims 1-34.

### *SEQUENCE COMPLIANCE*

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 C.F.R. § 1.821(a) (1) and (a) (2). This application fails to comply with the requirements of 37 C.F.R. § 1.821 through 1.825 due to the sequences in Table 2 (page 41 of the Specification), and no submission of the following items. Therefore, applicants are required to submit the following:

1. As a separate part of the disclosure on paper copy or compact disk copy, a "Sequence Listing" as 37 C.F.R. § 1.821(c).

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2. A copy of the "Sequence Listing" in computer readable form as required by 37 C.F.R. § 1.821 (e).
3. A statement that the content of the paper and computer readable copies are the same and include no new matter, as required by 37 C.F.R. § 1.821 (f) and 37 C.F.R. § 1.821 (g).
4. Each sequence in the specification is required to have a SEQ ID NO. therewith.

Applicants are given the same response time regarding this failure to comply as that set forth to respond to this office action. A complete response to this office action includes compliance with this sequence rule compliance requirement. Failure to respond to this requirement may result in abandonment of the instant application or a notice of a failure to fully respond to this office action.

#### **Claims Rejected Under 35 U.S.C. § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 9, 11, 14, 17-24, 27, 28, 31, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Chong et al.

Chong et al. describes profiling proteins of whole cell lysates wherein protein fractions are separated by non-porous reverse phase HPLC and analyzed using matrix-assisted laser desorption/ionization time-of-flight mass spectrometry (MALDI-TOFMS) (Abstract; page 1987, column 1, lines 5-7; and page 1993, Column 1, lines 6-10). The authors were able to distinguish

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protein profiles from malignant and normal breast epithelium cell lysates, giving different and distinguishable protein profiles of different cell types (page 1987, Column 1, lines 7-35).

Fractions were analyzed using MALDI-TOFMS to ascertain their molecular weights and observed protein expression (p 1987, Column 1, lines 36-37). Prior to MALDI-TOFMS analysis the cell lysates/sample were treated with external agents (p 1987-1989, "Matrix, substrate and sample preparation" section). Beckman System Gold HPLC utilized in this work includes a System Control Center display and keypad permitting the control of not only the device, but also external modules (page 1989, Column 1, lines 16-21). Further, data was recorded and processed on a computer (page 1989, Column 2, lines 16-19). Chong et al. illustrate the MALDI-TOF mass spectra data obtained of malignant and normal whole cell lysates of the MCF-10 cell lines (page 1988; and page 1989, Column 2, lines 41-47). Thus, Chong et al. clearly anticipates the instantly claimed invention.

#### *CLAIM OBJECTIONS*

Claims 15 and 16 are objected to as being improperly dependent; the claims are dependent to each other. However, to further prosecution claim 15 is interpreted to be "The method of Claim 14....". Applicants are required to remove said improper dependency in response to this office action.

Claims 21 (line 3) and 34 (line 2) are objected to due to the misspelling "oa" as set forth therein.

#### *OBJECTION OF DISCLOSURE*

The disclosure is objected to because of the following informalities:

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The disclosure is objected to because it contains an embedded hyperlinks and/or other forms of browser-executable code and delete them on page 34, line 18. Embedded hyperlinks and/or other form of browser-executable code are impermissible in the text of the application as they represent an improper incorporation by reference. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See M.P.E.P. § 608.01 and § 608.01(p).

**Appropriate Correction Is Required.**

**No Claims Are Allowed.**

*EXAMINER INFORMATION*

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 C.F.R. § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703) 305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Channing S. Mahatan whose telephone number is (703) 308-2380. The examiner can normally be reached on M-F (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward, Ph.D., can be reached on (703) 308-4028.

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Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst, William Phillips, whose telephone number is (703) 305-3482 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

Date:

*faly* 25, 2002

Examiner Initials:

*GM*

*Ardin H. Marschel*  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER